The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HERMAN RODRIQUEZ,
NEWTON JAMES SMITH JR., and CLIFFORD JAY SPINAC

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Appeal 2006-3362
Application 09/838,365[1]
Technology Center 2100

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Decided: September 21, 2007

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Before: MAHSHID D. SAADAT, ROBERT E. NAPPI, and JAY P LUCAS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed April 19, 2001. The real party in interest is International
Business Machines Corp.

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 18 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method, system and computer program for enlarging the size of images in an electronic document. In the words of the Appellants:

> The present invention provides a method, program and apparatus for providing access to alternate images in an electronic document. The present invention comprises identifying an initial image to be displayed in an electronic document (typically a web page) and then determining if alternate versions of the image are available for display. If alternate versions of the image are available, they are provided within the same electronic document. The alternate images differ from the initial image in size and resolution, allowing users with visual impairments to access larger, higher resolution images. The user accesses the alternate images by means of a selector displayed within the electronic document. When selected, the alternate image replaces the initial image in the electronic document, and the document is reformatted.

(Specification 3).

Claim 1 and Claim 15 are exemplary:

1. A method for providing alternate images in an electronic document, comprising:

identifying an initial image to be displayed in an electronic document;
explicitly providing references to alternate images of the initial image within, the same electronic document, wherein the alternate images differ from the initial image in size and resolution, and wherein the alternate images are different-sized versions of the initial image;
displaying the initial image;
providing a selector for accessing the alternate images; and

responsive to receiving user selection input, replacing the initial image with an alternate image and reformatting the electronic document.

15.   A computer program product in a computer readable medium for use in a data

processing system, for providing alternate images in an electronic document, the computer program product comprising:

instructions for identifying an initial image to be displayed in an electronic document;

instructions for explicitly providing references to alternate images of the initial image within the same electronic document, wherein the alternate images differ from the initial image in size and resolution, and wherein the alternate images are different-sized versions of the initial image;

instructions for displaying the initial image;

instructions for providing a selector for accessing the alternate images; and

responsive to receiving user selection input, instructions for replacing the initial image with an alternate image and reformatting the electronic document.

The prior art relied upon by the Examiner in rejecting the claims on

appeal is:

| Blumberg | US 6,708,309 B1 | Mar. 16, 2004 |
| Scott | US 2002/0000998 A1 | Jan. 3, 2002 |

Rejection:

All of the claims, 1 to 18, stand rejected under 35 U.S.C. § 103(a) for

being obvious over Scott in view of Blumberg.

Appellants contend that the claimed subject matter is not rendered

obvious by Scott in combination with Blumberg as the references fail to

disclose key limitations of the claims. The Examiner contends that each of

the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).[2]

We affirm-in-part.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the references Scott and Blumberg teach the alternate images and the reformatting of the document as claimed.

FINDINGS OF FACT

1. Appellants have invented a method, program and apparatus (hereinafter "method") for providing user-selectable sized images in an electronic document. When a larger image size is desired in a document, the invention allows the user to view a larger image with increased resolution, so that a sharp picture quality is maintained. (Specification 11: 21 *ff*). The invention is illustrated in Figure 5 of the Specification. The selector of the image size is

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[2] Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young,* 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

under user control, and may be as simple as arrows on the screen. (Specification 15, top). The documents are envisioned as web pages, with HTML tags referencing a source document containing the image. (Specification 11: 30+). A browser, adapted according to the invention, may continue to download a larger size image into memory while the user is viewing the thumbnail first image. (Specification 13, top).

2. Appellants have specified that the invention may be implemented as computer instructions on a computer readable medium, and state, "Examples of computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and transmission-type media, such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions." (Specification 15: 24 *ff*).

3. The reference Scott teaches, in the context of a browser displaying a web page, the display of small thumbnail images representing full desired images, which thumbnails can be enlarged gracefully into larger, high resolution images. (¶ 0074). While the enlargement of the thumbnail on the screen is being animated using crude pixel replication (¶ 0075, Fig. 5), the system is retrieving a new, larger, higher resolution image that will replace the smaller image on the web page. (*Id.*). Control of the enlargement is performed using a mouse clicking on a control

device on the screen. (¶ 0076, ¶ 0096). When a portion of an image is enlarged, as viewed in Figures 17A and 17B, the larger image replaces the smaller one, which results in the entire displayed page being reformatted to show the larger window 140 now overlapping other windows, such as 136.

4. The Blumberg reference teaches scaling of images in electronic documents. (Col 2, l. 20). As the images enlarge, the document is altered to display the larger resolution and sized view. (Fig. 4A through 4C). Document pages are indicated as being of HTML format (Col 6, top paragraph; Col 10, l. 60). Scalable images are indicated to be either embedded or referenced by links in the base document (Col 11, bottom). The process of assigning the right image to be embedded into an HTML document (Col 10, l. 58) is performed by a process referring to a specific JPEG image (Col. 11, top).

PRINCIPLES OF LAW

On appeal, Appellants bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

"To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness. ... On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness." [citations removed] *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

Both anticipation under 35 U.S.C. § 102 and obviousness under § 103 are two-step inquiries, in which the first step is a proper construction of the claims and the second step requires a comparison of the properly construed claim to the prior art. *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933, 69 USPQ2d 1283, 1286 (Fed. Cir. 2003).

Laws of nature, physical phenomena and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981).

The test for statutory subject matter is whether the claimed subject matter is directed to a "practical application," i.e., whether it is applied to produce "a useful, concrete and tangible result." *See State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998).

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1 to 18 under 35 U.S.C. § 103(a). Reviewing the Findings of Facts cited above and the documents of record, we find that the Examiner has presented a prima

facie case for the rejection of all claims. (Answer 3 - 8). In response, Appellants have presented a number of arguments in opposition to that rejection.

Appellants' first argument is summarized on page 13 of the Brief. In speaking of the Scott reference, Appellants state, "There is simply no teaching of *providing references to a plurality of alternate images* _within_ *the same electronic document as the initial image*, as expressly recited in Claim 1. Nor do the teachings of the cited Blumberg reference overcome this teaching deficiency." Based on our reading of the references described above (FF 1, 3), we find that in both Scott and Blumberg the smaller thumbnail image is replaced on the displayed document by the larger sized and higher resolution image of the same subject matter. Appellants further contend that the electronic document is not reformatted as claimed in the references (Brief 14, middle). For the reasons stated by the Examiner, page 9 middle, the document with the enlarged image embedded is necessarily reformatted, as the word is commonly accepted. The appearance of the document is changed in both references, Scott and Blumberg. (Also see FF 1, 3).

With respect to claim 4, Appellants contend that the Blumberg reference has no teaching of an HTML image tag having an alternate image attribute specifying the alternate image. (Brief 15, middle). We have carefully studied Blumberg, and agree with the Examiner (Answer 10, all) that the referencing of an unique JPEG image to be placed in an HTML document at a certain point renders claim 4 obvious over the teaching.

We cannot extend the Blumberg teaching to claim 5, however. The references simply do not teach the reflowing of the text around the image, as specified by claim 5, when read in the context of the Specification.

Appellants' arguments with respect to claims 11, 12, 16, and 18 concerning the images being in the same document (Brief 16, 17) are very similar to those with respect to claim 1. The arguments are not persuasive for the reasons expressed.

CONCLUSION OF LAW

Based on the findings of facts and analyses above, we conclude that the Examiner erred in rejecting claim 5. The rejection of that claim is reversed. The rejection of all the other claims, 1 to 4, and 6 to 18, is affirmed.

OTHER ISSUES

Examiner is alerted to the wording in the Specification at the bottom of page 15, and repeated in FF 2 above. An example of a computer readable medium as specified in claims 15 and 16 is defined by the Specification to include "transmission type media such as … wireless communication links using … radio frequency transmissions." (Specification 15: 25 – 31). Thus, as defined in this application, a computer readable medium includes a mere signal under transmission, not necessarily a physical tangible object. Such a claim for computer instructions is not considered by this office to be statutory under 35 U.S.C. 101.[3] As claims 15 and 16 have received

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[3] See, e.g., *In re Nuijten*, No. 2006-1371, slip op. at 8 (Fed. Cir. Sep. 20, 2007). *Ex Parte Hartmann*, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non- precedential). 'Signals' are not statutory subject

affirmance of their rejections under the art of record, a rejection for lack of

statutory subject matter is not considered at this moment to be necessary.

However, Examiner is advised to keep this consideration in mind if the

prosecution continues.

DECISION

The Examiner's rejection of claim 5 is reversed. The rejection of

claims 1 to 4 and 6 to 18 is affirmed.

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matter. See also "Interim Guidelines for Examination of Patent Applications
for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, Annex
IV(c) (Nov. 22, 2005).

AFFIRMED IN PART

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